

### **REMARKS/ARGUMENTS**

These remarks are submitted in response to the Office Action of June 21, 2007 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

In the Office Action, Claims 7, 8, 14, 17-19, 30, and 31 were objected to due to informalities. Claims 15-33, 38, and 39 were rejected under 35 U.S.C. § 101. Claims 1-3, 5, 15-17, 19, 24-26, and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,791,582 to Linsey, *et al.* (hereinafter Linsey). Claims 1-3, 9-12, 14-17, 20, 22, 24-26, 32, and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application 2005/0086309 to Galli, *et al.* (hereinafter Galli). Claims 4, 18, 27, and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Galli in view of U.S. Patent 7,069,003 to Lehtikainen, *et al.* (hereinafter Lehtikainen). Claims 6-8 and 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Linsey in view of :Blogging: Genius Strategies for Instant Web Content:, by Biz Stone, Publisher: New Riders, Pub. Date September 11, 2002 (hereinafter Stone). Claims 13, 23, and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Galli in view of Stone.

Although Applicants respectfully disagree with the rejections, Applicants nevertheless have amended certain claims so as to expedite prosecution of the present application by emphasizing certain aspects of the invention. Applicants respectfully note, however, that the amendments are not intended as, and should not be interpreted as, the surrender of any subject matter. Accordingly, Applicants respectfully reserve the right to present the original version of any of the amended claims in any future divisional or continuation applications from the present application.

In particular, Applicants have amended independent Claims 1, 15, 16, and 24 have been amended to further emphasize certain aspects of the invention. Applicants have amended independent Claim 15 to address the issues raised under under 35 U.S.C. § 101. Applicants also have amended dependent Claims 7, 8, 14, 17-19, 30, and 31 so as to address the stated objections. Applicants thank the Examiner for suggesting language to overcome the objections.

The claim amendments, as discussed herein, are fully supported throughout the Specification. No new matter has been introduced by virtue of any of the claim amendments.

**Patentable Subject Matter Under 35 U.S.C. §101**

As amended, independent Claim 15 recites an information processing system on which resides an instant messaging client for executing therein. Applicants respectfully submit that these features constitute patentable subject matter.

With respect to independent Claims 16 and 38, Applicants respectfully note that the claims are each directed to systems. The claims use "means-for" language as explicitly recognized under 35 U.S.C. § 112, sixth paragraph. Applicants respectfully submit, therefore, that the claims should be accorded their "broadest reasonable interpretation," MPEP § 2181, and should be read in the context of the combination of hardware and software explicitly set forth in the Specification for carrying out the procedures and functions set forth. (See, e.g., Specification, paragraph [0026] describing the necessary hardware for establishing an instant messaging session, which is an element of the claims.)

Moreover, in reciting the establishment of a session and the publishing of a transcript of the session, the claims clearly are directed to more than a concept or abstract idea. See, e.g., *State Street Bank & Trust v. Signature Financial Group*, 47 USPQ2d

1596, 1599 (Fed. Cir. 1998) (transforming data representing monetary values held to be a concrete, useful, and tangible result); see also *AT&T Corp. v. Excel Communication, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999) (adding a "primary interexchange carrier (PIC) indicator" in the context of long-distance telephony services found to be patentable subject matter.) Applicants respectfully submit, therefore, that the claims indeed recite patentable subject matter.

With respect to independent Claims 24 and 39, the claims are not directed to software *per se*. Both Claim 24 and Claim 39 explicitly recite computer-readable storage media, and accordingly should be construed as articles of manufacture. The steps recited in the claims include establishing an instant messaging session and, in response to detecting a scheduled event, publishing a transcript of the session. These are as much concrete, tangible, and useful results as, for example, transforming financial data or adding a PIC indicator to telephony switching data. Accordingly, Applicants respectfully maintain that the claims are drawn to patentable subject matter.

### **Certain Aspects Of Applicants' Invention**

Prior to addressing the cited references, it may be useful to reiterate certain aspects of Applicants' invention. One embodiment of the invention, typified by Claim 1, is a method of sharing instant messaging transcripts.

The method can include establishing an instant messaging session, and receiving a user request to publish a transcript of the session to one or more Weblogs. The method further can include determining a destination of at least one Weblog. (See, e.g., Specification, paragraph [0023], lines 7-9; paragraph [0039], lines 1-5; and paragraph [0044], lines 1-9.) Additionally, the method can include generating an indicator indicating at least one of a format, font, and color in which the transcript is to be published. (See, e.g., paragraph [0023], lines 7-9; paragraph [0039], lines 3-7; and

paragraph [0044], lines 1-9.) The method also can include publishing the transcript to the at least one Weblog according to the indicator.

**Claims 1-3, 5-13 and 15-17, 19-26, and 28-36**

As noted above, independent Claims 1, 15, 16, and 24 were rejected as being anticipated by Linsey. Linsey is directed to a system and method for managing "collaboration space by providing users of the collaboration space a report of events and happenings throughout a place that are [of] current interest." (Col. 3, lines 46-51.)

At page 5 of the Office Action, it is stated that Linsey discloses receiving a request to publish a transcript of a session to a Weblog. In portions cited in the Office Action, Linsey provides as follows:

"Users may be allowed to copy the transcripts of a chat into a QuickPlace page, or to save the chat as a whole as a page. An alternative type of chat is a place chat, which in QuickPlace by default is the whole QuickPlace, and may be made to support persistence--i.e., if may be rendered capable of loading the prior transcript when the user opens the chat window." (Col. 32, lines 23-30.)

Applicants respectfully submit, however, that Linsey does not expressly or inherently teach every feature recited in independent Claims 1, 15, 16, and 24. For example, Linsey does not teach, upon receiving a request to publish an IM transcript to one or more Weblogs, determining a destination of the at least one Weblog, as recited in Claims 1, 15, 16, and 24. Likewise, Linsey does not teach generating an indicator

indicating a format, a font, and/or a color in which the transcript is to be published, as also recited in Claims 1, 15, 16, and 24. It follows, therefore, that Linsey similarly does not teach publishing the transcript to the Weblog according to the indicator, as further recited in Claims 1, 15, 16, and 24.

Accordingly, Linsey does not expressly or inherently teach every feature recited in Claims 1, 15, 16, and 24. Applicants respectfully submit, therefore that Claims 1, 15, 16, and 24 define over the prior art. Applicants further respectfully submit that whereas each of the claims depending from Claim 1, 15, 16, or 24 recites additional features, these dependent claims likewise define over the prior art

**Claims 4 14, 18, 27,, 37, 38, and 39 Predate Galli**

As also noted above, independent Claim 14 was rejected as being anticipated by Galli. Independent Claims 37, 38, and 39, as well as dependent Claims 4, 18 and 27, were rejected as being unpatentable over Galli in view of Lehtikoinen. Although Applicants respectfully disagree, Applicants respectfully submit that the issue is moot because Applicants' invention predates the October 6, 2003 effective date of Galli.

Applicants conceived of their invention at least as early as February 23, 2003 and actively pursued its reduction to practice from a date prior to the publication date of Galli. In support of the assertion, Applicants submit the Declarations attached hereto in accordance with 37 CFR § 1.131. The Declarations establish conception and continuing diligence from a time prior to the publication date of Galli to the filing of the Application.

Along with the Declaration, Applicants also submit herewith, as Exhibit "A," a copy of Confidential Invention Disclosure No. BOC8-2003-0047, titled *System and Method for Generating Templated Weblogs from Interactive Communication Client Software* (hereinafter Disclosure). The Disclosure was created on February 23, 2003 and submitted on March 12, 2003 by Applicants to an intellectual property (IP) professional

employed by the assignee of Applicants' invention International Business Machines Corporation (IBM). The Disclosure was insubstantially modified on March 13, 2003. The description of the invention itself, however, was not modified after the Disclosure was initially submitted. Indeed, as noted below, established IBM procedures for handling all such disclosures preclude any modification to the description of the invention once it has been submitted by an inventor. The Disclosure has not been revised subsequent to March 13, 2003.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as February 23, 2003.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the Applicants reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from a date prior to the effective date of Galli to the date that the Application was filed. As expressly affirmed in the Declaration, Applicants from at least February 23, 2003 through the filing of the Application, worked

diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house IP professionals during an internal review of the invention, including assessing the invention in the context of related literature. Subsequently, Applicants worked with outside counsel retained by IBM to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

Evidence of Applicants' due diligence is submitted herewith in the form of various documents. Exhibit "B" is a letter dated July 8, 2003, instructing outside counsel to prepare the Application. A draft was sent to the inventors by outside counsel on November 29, 2003, as evidenced by Exhibit "C." The inventors responded with edits to the draft on the same day, as evidenced by Exhibit "D." A revised draft was sent by outside counsel to the inventors on December 2, 2003, as evidenced by Exhibit "E." The Application was filed December 15, 2003

Applicants respectfully submit that it was reasonable for Applicants to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence, notwithstanding the constraints of other work obligations, in preparing the Application. Applicants further respectfully submit that the evidence of specific activity on specific dates clearly evidences Applicants' prior conception and diligence in pursuing a reduction to practice from a time prior to the publication date of Galli. Accordingly, Applicants respectfully request that the rejections based upon Galli be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: September 21, 2007

A handwritten signature in cursive script, appearing to read "Richard A. Hinson", written over a horizontal line.

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